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| APPLICATION NO.                    | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|------------------------------------|-------------|----------------------|---------------------|------------------|
| 10/785,605                         | 02/23/2004  | Dane Scarborough     | LEVL110             | 3179             |
| 21658                              | 7590        | 11/15/2004           | EXAMINER            |                  |
| DYKAS, SHAVER & NIPPER, LLP        |             |                      | BENNETT, GEORGE B   |                  |
| P.O. BOX 877                       |             |                      | ART UNIT            | PAPER NUMBER     |
| 802 WEST BANNOCK STREET, SUITE 405 |             |                      |                     | 2859             |
| BOISE, ID 83701                    |             |                      |                     |                  |

DATE MAILED: 11/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| <b>Office Action Summary</b> | Application No.<br>10/785,605  | Applicant(s)<br>SCARBOROUGH, DANE |
|------------------------------|--------------------------------|-----------------------------------|
|                              | Examiner<br>G. Bradley Bennett | Art Unit<br>2859                  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1)  Responsive to communication(s) filed on 23 February 2004.

2a)  This action is FINAL.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4)  Claim(s) 1-22 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1-22 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on 23 February 2004 is/are: a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All    b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 2 and 3.  
4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: \_\_\_\_.

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 1-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lyle (US Pat. No. 2,347,273) in view of Sears (US Pat. No. 5,671,543).

3. Lyle discloses the invention substantially as claimed. Lyle sets forth a tape **6** with first and second indicia, wherein one set can be seen through a transparent window **12** using a reference mark/cursor **14**. The second indicia can be seen at the opening **11** using a reference mark/cursor, which is the opening itself. However, Lyle does not disclose a marking means near the opening as claimed. Sears discloses any known marking means near the opening of a tape measure for the purpose of marking a piece of work after a particular measurement has been made on the piece of work. Since the marking means is not limited to any particular means, Sears inherently discloses the claimed shapes. Furthermore, assuming *arguendo* that Sears does not disclose the claimed shapes, modifying the shape of the Sears teaching wouldn't render the new device patentable, since courts have held that mere changes in shape of a known device are obvious [see *In re Dailey*, 149 USPQ 47 (CCPA 1976)]. Therefore, it would have been obvious at the time the invention was made for one of ordinary skill in

the art to use a marking means as taught by Sears in conjunction with the device of Lyle for the purpose of allowing a person to mark a piece of work with when making measurements with Lyle device.

### ***Double Patenting***

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-22 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3 of U.S. Patent No. 6,701,636 in view of Lyle (US Pat. No. 2,347,273).

6. The applicant's prior application discloses a tape measure with marking means substantially as claimed as set forth in '636, claims 1-3. However, '636 does not set forth the tape with two sets of indicia, a window, reference marks and a cursor as claimed. Lyle sets forth a tape **6** with first and second indicia, wherein one set can be seen through a transparent window **12** using a reference mark/cursor **14**. The second indicia can be seen at the opening **11** using a reference mark/cursor, which is the

opening itself. Both sets of indicia will provide the same indication for the purpose of allowing a user of the device to view whichever set of indicia is most convenient.

Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to use the indicia, window, and mark/cursor taught by Lyle in conjunction with the '636 device to provide the '636 device with plural viewing options.

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Please note that US Pat. No. 3,253,531 has been crossed-off the IDS. This patent number did not match the name Eberhart and was related louver adjusting mechanism. Please provide the correct patent number for the Eberhart reference for consideration.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to G. Bradley Bennett whose telephone number is 571.272.2237. The examiner can normally be reached on M-TH 8:30-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diego F.F. Gutierrez can be reached on 571.272.2245. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
G. Bradley Bennett  
Primary Examiner  
Art Unit 2859

gbb  
12 NOV 2004